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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,418	09/25/2003	Jaroslav Sranka	150-129	5062
Steven S. Payne 8027 ILIFF Drive Dunn Loring, VA 22027				
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EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
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05/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,418

Applicant(s)

SRANKA, JAROSLAV

Examiner

VICTOR MACARTHUR

Art Unit

3679

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on 3/28/2001. It is noted, however, that applicant has not filed a certified copy of the 0101116-2 application as required by 35 U.S.C. 119(b).

Abstract

Applicant's abstract remains objected to for the reasons stated on p.2 of the previous Office Action rejection mailed 11/3/2006. Examiner notes that applicant's 2/27/2009 submission states that the abstract has been amended on an attached sheet. However, no such attached sheet can be found.

Drawings

Applicant's drawings filed June 21 2006 remain objected to for the reasons stated on p.2 of the previous Office Action rejection mailed 11/3/2006. Examiner notes that contrary to applicant's argument, applicant's filing of 10/20/2005 (presumably the 10/21/2005 filing since not filing exists for 10/20/2005) does not overcome the objection to the 11/3/2006 filed drawings. Drawings filed prior to those objected to cannot be relied upon to overcome such rejection.

Specification

The disclosure is objected to because for failing to expressly set forth the corresponding structure, material, or acts that perform the claimed means (or step) plus function limitations "means for transferring"(line 3 of claim 33), "means for attaching" (line 6 of claim 33), "means of quick-couplings" (line 2 of claim 35), and "means of quick-coupling" (line 2 of claim 38).

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

- Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, **without introducing any new matter** (35 U.S.C. 132(a)); or
- State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

Claim Objections

Claims 33-42 are objected to because of the following informalities:

- The term "and/or" (line 3 of claim 33) is unclear.
- "means for transferring" (line 3 of claim 33) is modified by structure "said means are flexible hoses or cables" (line 4 of claim 33) that may be sufficient to perform the

claimed function such that it is unclear if 35 U.S.C. 112 6th paragraph is being evoked.

- It is unclear if “means of a quick-coupling” (line 2 of claim 38) is meant to refer to “means of quick-couplings” (line 2 of claim 35) or to additional elements.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Line 1 of claim 33 recites “An industrial robot, comprising: a swivel...”, whereas previous presented (see filing of 6/21/2006) claim 22 recited “A swivel for an industrial robot”. That is to say, originally applicant claimed a swivel that was separate from and intended for use with a robot, whereas the current claims recite a swivel that is comprised within (part of) a robot. Is applicant merely amending the swivel to be labeled as a robot? Is applicant attempting to switch inventions from a subcombination swivel to a combination robot and swivel? If not how can applicants’ disclosed invention provide antecedent basis for both a swivel that is part of a

robot and a swivel that is separate from a robot? It appears that such a dual purpose swivel constitutes new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 1 of claim 33 recites "An industrial robot, comprising: a swivel...", whereas previous presented (see filing of 6/21/2006) claim 22 recited "A swivel for an industrial robot". That is to say, originally applicant claimed a swivel that was separate from and intended for use with a robot, whereas the current claims recite a swivel that is comprised within (part of) a robot. Is applicant merely amending the swivel to be labeled as a robot? Is applicant attempting to switch inventions from a subcombination swivel to a combination robot and swivel? If not how can applicants' disclosed invention provide antecedent basis for both a swivel that is part of a robot and a swivel that is separate from a robot?

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 is done as best understood by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (US 2,641,629) (in a manner substantially as was detailed for claims 22 and 24-32 in the previous Office Action rejection mailed 11/03/2006).

Note that merely labeling a swivel as "an industrial robot" does not overcome the applied swivel art since the claims do not recite any "robot" structure missing from the swivel art. In other words the term "industrial robot" as currently recited in the claims is taken to be a mere label of a swivel since no non-swivel structure is recited. Applicant is reminded that where there is physical identity between the subject matter of the claim and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art. In re Pearson, 494 F. 2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Lemin, 326 F. 2d 437, 140 USPQ 273 (CCPA 1964).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 34, 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtot (US 3,026,129) in view of Zeigler (US 6,094,922) (in a manner substantially as was detailed for claims 22, 24, 26-32 in the previous Office Action rejection mailed 11/03/2006).

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive. The prior art discloses all of applicant's newly added limitations as is detailed in the rejections above (e.g., "industrial robot" is a mere label for a swivel since the claims do not recite any non-swivel structure).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

May 18, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679